

### REMARKS

Claims 1-3 are pending and at issue in the application with claims 1 and 3 being independent claims. Claims 1-3 have been amended. As a result, two independent claims remain in the application as previously paid for, and three total claims remain in the application as previously paid for. Authorization to charge deposit account number 13-2855 is submitted herewith for the requisite surcharge fee of \$790.00. The applicants believe to additional fee is due. However, the commissioner is hereby authorized to charge any deficiency in the amount enclosed or any additional fees which may be required under 37 C.F.R. 1.16 or 1.17 to Deposit Account No. 13-2855. Reconsideration and withdrawal of the rejections in view of the remarks below is respectfully requested.

The applicants respectfully traverse the rejections of claims 1-3 as unpatentable over Kakuta (U.S. Patent No. 6,456,900). The applicants submit that claims 1-3 are not rendered obvious by Kakuta. The action does not establish a prima facie case of obviousness because Kakuta fails to disclose all of the limitations of claims 1-3, the action provides insufficient motivation to modify Kakuta, and the action has not demonstrated where Kakuta discloses all of the limitations as recited by claim 3.

Kakuta fails to disclose all of the limitations of claims 1 and 2. In particular, Kakuta does not disclose or suggest an operating unit comprising a control means for controlling the opening and/or the closing of the parcel boxes associated with the operating units. Although Kakuta discloses a settling terminal 210, the settling terminal 210 receives payment of the charge by a customer, generates settling information that evidences completion by a customer of due settlement and issues a release code for unlocking an appropriate locker 221. (See column 12, lines 1-6). After a customer has settled payment at the settling terminal 210, the customer receives the release code and inputs the code through the operating unit 220. (See column 12, lines 29-46). In other words, the settling terminal 210 is essentially a payment center that merely provides a release code to the customer upon customer payment. The settling terminal 210 does not control the opening and/or closing of parcel boxes. Accordingly, the settling terminal 210 is not the at least two operating units each comprising a control means for controlling the opening and/or the closing of the parcel boxes associated with the operating units, as recited by claims 1 and 2.

Further, Kakuta does not disclose or suggest an electronic parcel box device comprising a central control unit. While Kakuta discloses a supervising center 201 that controls several delivering equipment 200, where each delivering equipment 200 comprises locker equipment 220 each having lockers 221 and one settling terminal 210, the supervising center 201 is not part of a delivering equipment 200. Instead, the supervising center 201 is provided via a network separate from the delivering equipment 200, and the delivery equipment 200 does not comprise the supervising center 201. By contrast, the electronic parcel box device of claims 1 and 2 comprises a central control unit.

Still further, Kakuta does not disclose or suggest that the supervising center 201 comprises an interface for flexibly associating parcel boxes with the operating units, thereby associating the control means of each operating unit to a different group of parcel boxes. Although the settling terminal 210 of a delivery equipment 200 is associated with the lockers 221 of the delivery equipment 200 (see Fig. 6; column 11, line 66 to column 12, line 6), each settling terminal 210 is always associated with all the lockers 221 and locker equipment 220 of a particular delivery equipment 200. In other words, each settling terminal 210 is always associated with the same lockers 221. Kakuta does not disclose the settling terminal 210 or any associated control means being flexibly associated with different groups of lockers 221.

Likewise, while Kakuta also discloses an operating unit 222 and a locker controlling part 223 which controls all of the lockers 221 of a particular locker equipment 220 (see Fig. 9, column 15, lines 42-60), Kakuta only discloses one such operating unit 222 and locker controlling part 223 for each locker equipment 220. As a result, each operating unit 222 and locker controlling part 223 is always associated with the lockers 221 of a particular locking equipment 220. In other words, each operating unit 222 and locker controlling part 223 is always associated with the same lockers 221. Kakuta does not disclose that either the operating unit 222 or the controlling part 223 is flexibly associated with different groups of lockers 221.

Because the settling terminal 210, operating unit 222 or locker controlling part 223 is always associated with the same group of lockers 221, it necessarily follows that the supervising center 201 cannot comprise an interface for flexibly associating the lockers 221 with operating units (whether they be the settling terminal 210, operating unit 222 or locker controlling part 223), thereby associating the control means of each operating unit to a

different group of lockers 221. While the action asserts that the supervisory center 201 flexibly controls the opening and closing of the doors of the electronic parcel boxes and manages orders from customers using the electronic parcel boxes, such an assertion is irrelevant to the language of the claims. In particular, claims 1 and 2 each recite that the central control unit comprises an interface to flexibly associate the parcel boxes with the operating units, thereby associating the control means of each operating unit to a different group of parcel boxes. Although the interfaces cited in the action can associate parcels to delivering equipments 200 and lockers 221, they do not associate operating units to lockers. Merely controlling the opening and closing of the lockers 221 does not associate the lockers 221 with different operating units (or control means thereof). As a result, Kakuta does not disclose or suggest a central control unit that comprises an interface for flexibly associating parcel boxes with operating units, as recited by claims 1 and 2.

It is clear that a prima facie case of obviousness cannot be maintained where all the limitations of a claimed combination are not taught or suggested by the prior art. See *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). See also MPEP 2143.03.

The action also does not establish a prima facie case of obviousness of claims 2 and 3 because the action has not provided a motivation to modify Kakuta as supported by the prior art. In particular, the motivation provided in the action regarding claim 2 (i.e., associating parcel boxes with functioning operating units when an operating unit malfunctions) is not found within the disclosure of Kakuta. Indeed, the action does not provide any indication as to the source of the motivation, whether explicitly or implicitly in the reference itself or in the knowledge generally available to one of ordinary skill in the art. Still further, the action does not provide any motivation with respect to the obviousness rejection of claim 3. It is clear that the prior art must make a suggestion of or provide an incentive for a claimed modification or combination of elements to establish a prima facie case of obviousness. In *re Oetiker*, 24 U.S.P.Q.2d 1443, 1446 (Fed. Cir. 1992); *Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. 1985). See also MPEP 2144. Accordingly, the grounds for rejection of claims 2 and 3 as asserted in the action fail to present a prima facie case of obviousness and cannot be sustained.

The action further does not establish a prima facie case of obviousness of claim 3 because the action has not demonstrated where Kakuta discloses all of the limitations as

recited by independent claim 3. The action appears to assert on page 6 that various limitations of independent claim 3 are disclosed by the cited portions of Kakuta. However, the action does not actually address the claim limitations of independent claim 3, which was amended to recite “a central database server ..., wherein postal parcels are delivered to individual electronic parcel box systems as a function of the filling status of the electronic parcel box systems.” Independent claim 3 does not recite “(c) a device 200 for delivering postal parcels to individual electronic parcel box systems as a function of the filling status of the electronic parcel box systems” as asserted in the action. As a result, the action does not specifically address where Kakuta discloses a central database server wherein postal parcels are delivered to individual electronic parcel box systems as a function of the filling status of the electronic parcel box systems. The Office bears the initial burden, on review of the prior art or on any other ground, of presenting a prima facie case of obviousness, and that the Office has not met that burden in the action. See MPEP 706.02(j) and 2143. Accordingly, the action has failed to properly account for the claim language of claim 3. As such, the grounds for rejection of claim 3 as asserted in the action fail to present a prima facie case of obviousness and cannot be sustained.

Kakuta also fails to disclose all of the limitations of claim 3. In particular, the order receiving center 202 is cited in the action as both an interface for flexibly associating the parcel boxes with the operating units (by reference to the rejection of claim 1) and as a central database server comprising memory for storing data about the filling status of the parcel box systems. However, it is clear from the language of claim 3 that the interface is part of a central control unit for each electronic parcel box system, and that the central database server is provided in addition to the electronic parcel box systems. As a result, the action’s assertion that the order receiving center 202 is the recited interface is entirely inconsistent with the further assertion that the order receiving center 202 is also the recited central database server 202.

Still further, Kakuta fails to disclose or suggest a central control unit comprising an interface for flexibly associated parcel boxes with operating units. As established above with reference to claims 1 and 2, the settling terminal 210, operating unit 222 or locker controlling part 223 is always associated with the same group of lockers 221. As such, the supervising center 201, as cited in the action, cannot comprise an interface for flexibly associating the lockers 221 with operating units (whether they be the settling terminal 210, operating unit

222 or locker controlling part 223), and Kakuta does not disclose or suggest a central control unit that comprises an interface for flexibly associating parcel boxes with operating units, as recited by claim 3.

It is clear that a *prima facie* case of obviousness cannot be maintained where all the limitations of a claimed combination, including the arrangement of each and every element as required by the claims, are not taught or suggested by the prior art. See *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). See also MPEP 2143.03.

Accordingly, the applicants respectfully submit that claims 1-3 are novel and non-obvious in view of the cited references and should be allowed. In light of the foregoing, the prompt issuance of a notice of allowance is respectfully solicited. Should the examiner have any questions, the examiner is respectfully invited to telephone the undersigned.

Respectfully submitted,

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